

### **REMARKS**

This responds to the Office Action dated May 24, 2007.

Claims 1 and 8-10 are amended. Claims 1-10 and 57-66 remain pending in this application.

#### **Declaration and Power of Attorney**

A new oath or declaration was required in compliance with 37 C.F.R. 1.67(a). Applicant would like to note that paragraph four of the previously filed Combined Declaration and Power of Attorney (copy enclosed) states:

“I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with 37 C.F.R. § 1.56 (attached hereto). I also acknowledge my duty to disclose all information known to be material to patentability which became available between a filing date of a prior application and the national or PCT international filing date in the event this is a Continuation-In-Part application in accordance with 37 C.F.R. § 1.63(e).”

The Office Action states:

The “duty to disclose” clause should read: “I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56.”, not “I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56.”

The only difference between the two quoted sentences includes the article “the” before the word “patentability.” Applicant respectfully submits that no reasonable person could find this difference to be of any consequence. Additionally, Applicant believes that the Declaration is adequate because 37 C.F.R. § 1.56 is incorporated into the Combined Declaration and Power of Attorney. Therefore, Applicant respectfully traverses the assertion that the oath or declaration is defective.

Applicant respectfully requests that the Examiner provides the legal basis for requiring the statement “I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56.”, including the legal basis for requiring the exact wording, in the next official communication, or withdrawal of the objection.

*§102 Rejection of the Claims Using Levine*

Claims 1, 6-10, 61, 65, and 66 were rejected under 35 U.S.C. § 102(b) as being anticipated by Levine (U.S. Patent No. 6,477,417, herein "Levine").

*Claim 1*

Claim 1 has been amended to better describe the recited subject matter.

Applicant respectfully traverses the rejection and submits that the Office Action does not set forth a *prima facie* case of anticipation because the cited portions of Levine do not provide the claimed subject matter. For example, Applicant is unable to find in the cited portions of Levine, among other things, a pacing circuit adapted to be inactive when an implantable medical device is configured to be an implantable cardiac monitor and capable of producing pacing pulses when the implantable medical device is configured to be an implantable pacemaker, as recited in claim 1.

Additionally, the Office Action states that "Examiner is interpreting Levine's device in the unipolar mode to comprise a cardiac monitor controller because it has monitoring functionality and a pacemaker controller in the bipolar configuration because it has pacing functionality." However, claim 1 does not merely recite a cardiac monitor controller and a pacemaker controller. The Office Action fails to assert where and how Levine provides that the alleged "cardiac monitor controller" is upgradeable to the alleged "pacemaker controller" when Levine's device changes from unipolar operation to bipolar operation, and Applicant is unable to find such teaching or suggestion in Levine.

Applicant respectfully requests reconsideration and allowance of claim 1.

*Claims 6-10, 61, 65, and 66*

Applicant respectfully traverses the rejection. Claims 6-10, 61, 65, and 66 are dependent on claim 1, which is believed to be allowable for at least the reasons set forth above. Therefore, the discussion above for claim 1 is incorporated herein to support the patentability of claims 6-10, 61, 65, and 66.

Applicant respectfully requests reconsideration and allowance of claims 6-10, 61, 65, and 66.

§102 Rejection of the Claims Using Lovett

Claims 1, 61, 65, and 66 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lovett et al. (U.S. 2004/0230229, herein "Lovett").

*Claim 1*

Claim 1 has been amended to better describe the recited subject matter.

Applicant respectfully traverses the rejection and submits that the Office Action does not set forth a *prima facie* case of anticipation because the cited portions of Lovett do not provide the claimed subject matter. For example, Applicant is unable to find in the cited portions of Lovett, among other things, a pacing circuit adapted to be inactive when an implantable medical device is configured to be an implantable cardiac monitor and capable of producing pacing pulses when the implantable medical device is configured to be an implantable pacemaker, as recited in claim 1.

Applicant respectfully requests reconsideration and allowance of claim 1.

*Claims 61, 65, and 66*

Applicant respectfully traverses the rejection. Claims 61, 65, and 66 are dependent on claim 1, which is believed to be allowable for at least the reasons set forth above. Therefore, the discussion above for claim 1 is incorporated herein to support the patentability of claims 61, 65, and 66.

Applicant respectfully requests reconsideration and allowance of claims 61, 65, and 66.

§103 Rejection of the Claims Using Lovett

Claims 6-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lovett.

Applicant respectfully traverses the rejection and submits that, pursuant to 35 U.S.C. § 103(c), Lovett is not available for supporting obviousness rejections. Applicant respectfully submits that the assignments on record for the present Application and Lovett provide evidence establishing their common ownership. See MPEP §§ 706.02(1)(1)-(2).

The present Application (U.S. Serial No. 10/712,776) and Lovett (U.S. Serial No. 10/462,001) were, at the time the present invention was made, owned by Cardiac Pacemakers, Inc, by nature of the assignments executed and filed for both of these applications. The assignment for U.S. Serial No. 10/712,776 was recorded on April 15, 2004 on Reel 015211, Frame 0734 with the United States Patent and Trademark Office. The assignment for U.S. Serial No. 10/462,001 was recorded on October 23, 2003 on Reel 014636, Frame 0973 with the United States Patent and Trademark Office.

Thus, Applicant respectfully submits that claims 6-10 are patentable pursuant to 35 U.S.C. §103(c). In making this procedural traversal, Applicant does not address the arguments of record and reserves the right to traverse same if the procedural traversal is not accepted.

Applicant respectfully requests reconsideration and allowance of claims 6-10.

*§103 Rejection of the Claims Using Levine or Lovett*

Claims 57-60 and 62-64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levine or Lovett.

Applicant respectfully traverses the rejection. Claims 57-60 and 62-64 are dependent on claim 1, which is believed to be allowable for at least the reasons set forth above. Therefore, the discussion above for claim 1 is incorporated herein to support the patentability of claims 57-60 and 62-64.

Applicant also submits that, as discussed above, Lovett is not available for supporting obviousness rejections pursuant to 35 U.S.C. § 103(c).

Applicant respectfully requests reconsideration and allowance of claims 57-60 and 62-64.

*§103 Rejection of the Claims Using Levine or Lovett and Morgan*

Claims 2-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levine or Lovett in view of Morgan (U.S. Patent No. 5,024,221, herein "Morgan").

Applicant respectfully traverses the rejection. Claims 2-5 are dependent on claim 1, which is believed to be allowable for at least the reasons set forth above. Therefore, the discussion above for claim 1 is incorporated herein to support the patentability of claims 2-5

Applicant also submits that, as discussed above, Lovett is not available for supporting obviousness rejections pursuant to 35 U.S.C. § 103(c).

Applicant respectfully requests reconsideration and allowance of claims 2-5.

*Reservation of the Right to Swear Behind References*

Applicant reserves its right to swear behind any references which are cited in a rejection under 35 U.S.C. §§102(e) and 103/102(e). Statements distinguishing the claimed subject matter over the cited references are not to be interpreted as admissions that the references are prior art.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6965 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

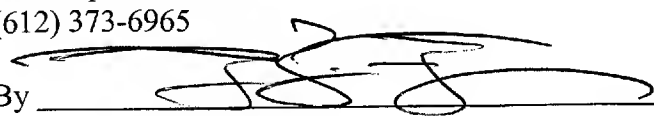
Respectfully submitted,

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Date

8-24-2007

By

  
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 24 day of August 2007.

Name

KATE GUNN

Signature

